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EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2686

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/447,284	Applicant(s) CAO ET AL.	
	Examiner Nghi H. Ly	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 15, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Jones et al (6,697,944).

Regarding claims 15 and 25, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public

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switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote handset from a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (column 4, lines 27-33, see "transmission through Internet").

Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Jones teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 10, lines 9-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jones into the system of Borland in order to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14).

Regarding claim 28, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing

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MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote handset from a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (column 4, lines 27-33, see "transmission through Internet").

Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Jones teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 10, lines 9-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jones into the system of Borland in order to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14).

4. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Rydbeck (WO 99143136).

Regarding claim 1, Borland teaches a cordless telephone (see Abstract), comprising: a remote handset (see fig. 2, handset 110), a base unit matched to the remote handset (see fig. 2, handset 120), and an MPEG audio player integrated within at least one of the remote handset and the base unit (see Abstract, "MP3", column 4,

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lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG").

Borland does not specifically disclose the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone.

Rydbeck teaches the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Borland in order to prevent telephone conversation from interfering with audio sounds.

Regarding claim 2, Borland further teaches the MPEG audio player is integrated within the remote handset (see column 5, lines 24-28).

Regarding claims 4 and 5, Borland further teaches the MPEG audio player is an MP3 (see Abstract, "MP3", column 4, lines 7-21, "MP3").

Regarding claim 29, Borland further teaches a cordless telephone (see Abstract), comprising: means for playing pre-loaded MP3 music from a remote handset of a cordless telephone (see fig. 2, handset 110), means for connecting a base unit of the cordless telephone to a public switched telephone network (PSTN) (fig. 1, see "PSTN" and column 4, lines 2-7).

Borland does not specifically disclose switching a remote handset of the cordless telephone from performing as a telephony device to performing as an audio player, and switching being initiated upon activation of a button on the remote handset of said cordless telephone.

Rydbeck teaches switching a remote handset of the cordless telephone from performing as a telephony device to performing as an audio player, and switching being initiated upon activation of a button on the remote handset of said cordless telephone (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Borland in order to prevent telephone conversation from interfering with audio sounds.

5. Claims 14 and 24 are rejected under 35 U.S.C 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Jones et al (6,697,944) and further in view of Ng (US 6,430,530).

Regarding claims 14 and 24, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote

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handset from a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the downloaded digital bit stream music comprised in an MPEG format is stored in memory in the remote handset (see column 4, lines 22-39, "storage in portable system").

Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Jones teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 10, lines 9-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jones into the system of Borland in order to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14).

The combination of Borland and Jones does not specifically disclose an MPEG format is stored in memory.

Ng teaches an MPEG format is stored in memory (see column 1, line 62-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ng into the system of Borland and Jones so that the user can decodes and plays the file (see Ng, column 1, line 62-65).

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6. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Tuoriniemi et al (US 5,978,689).

Regarding claims 9 and 19, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: playing of the pre-loaded MP3 music from the remote handset of a cordless telephone (see column 5, lines 24-28), connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7) and playing of the pre-loaded MP3 (column 4, lines 27-33, see "storage in portable systems" and column 4, lines 43-47, see "playback").

Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Borland so that the user won't miss the telephone call while enjoy listening to music.

Regarding claims 10 and 20, Borland teaches the method of integrating an MPEG audio player in a cordless telephone according to claims 9 and 19 (see Abstract,

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"MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG").

Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Borland so that the user won't miss the telephone call while enjoy listening to music.

Response to Arguments

7. Applicant's arguments filed 11/28/05 have been fully considered but they are not persuasive.

On pages 8 and 9 of applicant's remarks, applicant argues that Jones discloses an MP3 player that downloads digital content files from the PC, Jones fails to even mention download of digital content files to a telephony device and Jones fails to disclose any application to a cordless telephone comprising a base unit and a remote handset.

The examiner, however, disagrees. Jones teaches a MP3 player that downloads digital content files from the Internet (see fig.3, direct connection between Internet 62 and portable device 70), (NOT a PC, as alleged by the applicant), and in response to

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applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), Jones teaches download of digital content files to a portable device (see fig.3, direct connection between Internet 62 and portable device 70) and the combination of Borland and Jones does indeed teach applicant's claimed invention as recited by claims 15, 25 and 28. In addition applicant's attention is directed to the rejection of claims 15, 25 and 28 above.

On pages 10 and 11 of applicant's remarks, applicant argues that Rydbeck fails to disclose a remote handset of a cordless telephone and a remote handset of a cordless telephone that can switch between performing as a telephony device and performing as an MPEG audio player, as recited by claims 1, 2, 4, 5 and 29.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a

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remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), Rydbeck the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone (see page 7, lines 2-4) and the combination of Borland and Rydbeck does indeed teach applicant's claimed invention as recited by claims 1, 2, 4, 5 and 29. In addition applicant's attention is directed to the rejection of claims 1, 2, 4, 5 and 29 above.

On page 12 of applicant's remarks, applicant argues that Jones fails to even mention download of digital bit stream music to a telephony device, much less to a remote handset of a cordless telephone, i.e., downloading digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source and NG fails to disclose or suggest application to a cordless telephone, as recited by claims 14 and 24.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and

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column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), Jones teaches download of digital content files to a portable device (see fig.3, direct connection between Internet 62 and portable device 70), Ng teaches an MPEG format is stored in memory (see column 1, line 62-65), and the combination of Borland, Rydbeck and NG does indeed teach applicant's claimed invention as recited by claims 14 and 24. In addition applicant's attention is directed to the rejection of claims 14 and 24 above.

On page 14 of applicant's remarks, applicant argues that Borland modified by Tuoriniemi would fail to disclose or suggest playing MP3 music from a remote handset of a cordless telephone and muting the playing of a pre-loaded MP3 music when the remote handset is active in a current telephone call, as recited by claims 9, 10, 19 and 20.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches a cordless telephone comprising a base unit and a remote handset (see fig.2, base unit 120 and handset 110) that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current

telephone call (see column 7, lines 49-55), and the combination of Borland and Tuoriniemi does indeed teach applicant's claimed invention as recited by claims 9, 10, 19 and 20. In addition applicant's attention is directed to the rejection of claims 9, 10, 19 and 20 above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone

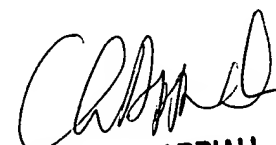
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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly.


01/24/06


CHARLES APPIAH
PRIMARY EXAMINER